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**OCT 31 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
Edward A. Hubbard	:	
Application No.: 09/834785	:	DECISION ON
Filing or 371(c) Date: 04/13/2001	:	PETITION
Attorney Docket Number: NING0008	:	

This is a decision in response to the renewed petition under 37 CFR 1.137, filed September 18, 2008. The petition is properly treated as a renewed petition to withdraw the holding of abandonment based upon failure to receive an Office action under 37 CFR 1.181.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due (Notice"), mailed July 25, 2006. The Notice set a three (3) month period for reply. No extensions of time were available. No reply having been received, the application became abandoned on October 26, 2006. A Notice of Abandonment was mailed December 26, 2006.

February 23, 2007 Petition under 37 CFR 1.181

Petitioner, the law firm of Fish & Richardson, filed a petition on February 23, 2007 and asserted that the Notice was never received. In support of this assertion, Petitioner stated that a search of the physical file and docket records indicated that the Notice was not received. Petitioner also filed a copy of a docket record from the law firm of Winstead Sechrest & Minick, the attorneys of record at the time the Notice was mailed. A review of the copy of the docket records from Winstead Sechrest & Minick indicated that the Notice was not received. No statement from anyone at the law firm of Winstead Sechrest & Minick, attesting to a search of the file jacket and docket records has been conducted, or that the search of the physical file and docket records indicate that the Notice was not receive, was filed.

It was also noted that the law firm of Fish & Richardson were no longer the attorneys of record in the application.

#### August 22, 2008 Decision dismissing petition

The petition was dismissed in a Decision mailed August 22, 2008. The Decision dismissing the petition noted that no statement from anyone at the law firm of Winstead Sechrest & Minick, attesting to non-receipt of the Notice, or attesting to a search of the file jacket and docket records, or that the search of the physical file and docket records indicate that the Notice was not received, was filed. Moreover, no copy of the master docket for the firm of Winstead Sechrest & Minick was filed. A statement from a person with knowledge of the docketing system at the law firm of Winstead Sechrest & Minick, attesting to non-receipt of the Notice, or attesting to a search of the file jacket and docket records, or that the search of the physical file and docket records indicate that the Notice was not received, was required. Also, a copy of the master docket record showing all replies docketed for a date three (3) months from the mail date of the Notice was required.

#### The present renewed petition

Applicant files the present renewed petition, co-executed by Robert A. Voigt Jr., of the law firm of Winstead Sechrest & Minick, asserting that the law firm of Winstead Sechrest & Minick does not maintain a Master Docket for all its docketed items. Applicant refers to Exhibit "B", the individual docket record for the application in question.

#### Applicable Law, Rules and MPEP

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the

**MPEP 711.03(c)**

Applicant asserts that the law firm of Winstead Sechrest & Minick does not maintain a Master Docket for all its docketed items. In view of this assertion, and the unavailability of a copy of the master docket record, the Office is unable to account for the situation where the Office action may have been received and mis-docketed. Further to this, it is noted that the law firm of Winstead Sechrest & Minick uses a post office box for receipt of correspondence from this Office. Accordingly, as noted in the Decision dismissing the petition mailed August 22, 2008, a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO, is required. The statement should establish that the docketing system is sufficiently reliable. The statement should address the process whereby correspondence from this Office and received at the post office box is entered into the relevant application files. Petitioner is reminded that the showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

By FAX: (571) 273-8300  
Attn: Office of Petitions

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/  
Derek L. Woods  
Attorney  
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